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| 09/819,687 | 03/29/2001 | Eiji Natori | 109121 | 3151 |
| 25944 | 7590 | 08/10/2005 | | |
| OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320 | | | EXAMINER GUERRERO, MARIA F | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2822 | |

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/819,687

Applicant(s)

NATORI, EIJI

Examiner

Maria Guerrero

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-25, 27-40, 52-55, 57, 59 and 60 is/are pending in the application.
- 4a) Of the above claim(s) 11-22, 25, 27-28, 30, 33, 35, 37-38, 52-55, 60 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23, 24, 29, 31, 32, 34, 36, 39, 40, 57 and 59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to the Amendment filed May 25, 2005.

Status of Claims

2. Claims 1-10, 26, 41-51, 56, and 58 are canceled. Claims 11-25, 27-40 and 52-55, 57, 59, and 60 are pending.

Election/Restrictions

3. This application contains claims 11-22 and 52-55 drawn to an invention nonelected with traverse in Paper No. 10 and claim 60 being withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. A complete reply to the rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Newly amended claim 25 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: amended claim 25 requires the embodiments of non-elected Species II (See Office Action mailed March 25, 2003).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25, 27-28, 30, 33, 37-38 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 23-24, 29, 31-32, 34, 36, 39-40, 57 and 59 are rejected under 35

U.S.C. 102(e) as being anticipated by Paz de Araujo et al. (U.S. 6,110,531).

5. Paz de Araujo et al. teaches feeding an electromagnetic wave and active species of a substance, which is at least part of raw material to a region on a substrate to form a ceramic film (col. 6, lines 50-55, col. 9, lines 8-40). Paz de Araujo et al. teaches a method of mixing a ferroelectric precursor with an active species and applying the film by misted CVD process (Fig. 3, col. 5, lines 21-30, 45-56, col. 13, lines 50-65, col. 14, lines 1-10).

Paz de Araujo et al. discloses the active species being a radical or ion of the raw material species (Fig. 3, col. 5, lines 21-30, col. 8, lines 8-30). Paz de Araujo et al. shows the active species being oxygen or nitrogen or inert argon gas, the active species being fed to the substrate (Fig. 3). Paz de Araujo et al. teaches forming a first ceramic film in an amorphous state (having low crystallinity) (col. 2, lines 19-25, col. 14, lines 50-65). Paz de Araujo et al. teaches a means for forming ceramic film including s means

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for feeding an electromagnetic wave and active species to the region smaller than the entire surface of the substrate (Fig. 2, 4, col. 6, lines 1-55).

6. Paz de Araujo et al. shows the thickness of the film being in the range of 50 to 5000 angstroms (col. 4, lines 24-27). Paz de Araujo et al., in a broad interpretation, shows the steps as claimed because the steps of forming the film-forming region, the non-film forming region, and the self-alignably ceramic film are taught by Paz de Araujo et al. reference (see Fig. 10-11, col. 13, lines 19-45, col. 14, lines 10-65).

Response to Arguments

7. Applicant's arguments filed May 25, 2005 have been fully considered but they are not persuasive. Claims Rejections under 35 U.S.C. 112 are withdrawn. Claims 23-24, 29, 31-32, 34, 36, 39-40, 57 and 59 stand rejected because the amendments do not overcome the rejections.

Applicant argued that Paz de Araujo et al. fails to disclose or suggest a film-forming section and a non-film forming region. However, in a broad interpretation of the claims, a person of ordinary skill in the art would recognize that Paz de Araujo et al. shows the steps as claimed because the steps of forming the film-forming region, the non-film forming region, and the self-alignably ceramic film are taught by Paz de Araujo et al. reference (see Fig. 10-11, col. 13, lines 19-45, col. 14, lines 10-65). In addition, Paz de Araujo et al. discloses a region for forming a ceramic film being part of a substrate (Fig. 10, col. 13, lines 19-50, col. 14, lines 26, col. 16, lines 5-20). Paz de Araujo et al. uses the term substrate in general and specific sense (col. 16, lines 5-20).

Paz de Araujo et al. also suggest that the invention is not limited to the presented embodiments and examples (col. 13, lines 20-50, col. 14, lines 10-25, col. 16, lines 5-20). Furthermore, the rejected claims are silent about the location of the film forming section and the non-film forming section on the substrate. Therefore, Paz de Araujo et al. anticipated the claimed subject matter.

8. In addition, the elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

9. Furthermore, during patent examination, the pending claims must be "given *>their< broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. > In re American Academy of Science Tech Center, F.3d , 2004 WL 1067528 (Fed. Cir. May 13, 2004)(The USPTO uses a different standard for construing claims than that used by district courts; during examination the USPTO must give claims their broadest reasonable interpretation.) < This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) >; Chef America, Inc. v. Lamb-Weston, Inc., 358 F.3d 1371, 1372, 69 USPQ2d

1857 (Fed. Cir. 2004). Therefore, the words of the claims have been given their plain meaning because there is not evidence of special definition in the specification.

10. In addition, the transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., > Invitrogen Corp. v. Biocrest Mfg., L.P., 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); < Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts").

11. Finally, "The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d

804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir.1998). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ423 (CCPA 1971).

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hintermaier et al. (US 6,120,846) and Mihara et al. (US 5,466,629) (incorporated by reference on Paz de Araujo et al. (U.S. 6,110,531)) are presented as evidence to support the conclusion that a person of ordinary skill in the art would recognize that the steps of forming the film-forming region, the non-film forming region are taught by Paz de Araujo et al.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria Guerrero whose telephone number is 571-272-1837.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amir Zarabian can be reached on 571-272-1852. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

August 5, 2005


MARIA F. GUERRERO
PRIMARY EXAMINER